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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/525,291	03/08/2005	Karen Ann McCue	102792-414)11088P3)	7805
27389 7590 06/24/2008 NORRIS, MCLAUGHLIN & MARCUS 875 THIRD AVE 18TH FLOOR NEW YORK, NY 10022			EXAMINER NGUYEN, TRI V	
			ART UNIT	PAPER NUMBER
			1796	
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			06/24/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/525,291	Applicant(s) MCCUE ET AL.	
	Examiner TRI V. NGUYEN	Art Unit 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 October 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 and 18-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15, 18-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Upon entry of the amendment filed on 10/29/2007, Claims 1, 21 and 23 are amended; Claim 25 is added and Claims 16 and 17 are cancelled. The currently pending claims considered below are Claims 1-15 and 18-25.

Upon review of the amendment, the rejections of the claims under 112(2) and 103(a) are maintained.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-15 and 18-25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Specifically claims 1, 21, and 23 from which all other claims depend, recite contradicting and indefinite limitations as to what is excluded and what components are optional. For example, it is unclear and indefinite how optical brighteners are optional while bleaches are excluded. Similarly, it is unclear what scope patent protection is being sought for in the exclusion of cationic quaternary ammonium components known to be effective against gram positive/negative type pathogenic, other known art antimicrobial constituents. It is noted that the court has held that compositions are indefinite for being defined in terms of properties alone. *Ex parte Spacht*, 165 USPQ 409 (PO Bd Pat App 1969); *Ex parte Slob* 157 USPQ 172 (PO Bd Pat App 1967); *Ex parte Pulvari*, 157 USPQ (PO Bd Pat. App 1966). ... it is unclear what is included and excluded by claimed language.

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Claims 2-15, 18-20, 22, 24 and 25 are dependent claims thus inherit the same deficiencies.

Claim Rejections - 35 USC § 103

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claims 1-15 and 18-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Crisanti et al.

Crisanti et al. teach a germicidal acidic hard surface cleaning composition which can comprise acids (col.3, line 5 et seq) including citric, sorbic, acetic, boric, formic, maleic, adipic, lactic and glycolic used singly or in conjunction with one another (col. 3, lines 25-27) such as citric and lactic (see Table I, Exs 5-7 and 17-18) in combination with a solvent including dipropylene glycol n-propyl ether, construed as a "water miscible glycol ether" (col. 4, line 24) or ethanol (col. 4, line 49) in a mixture (col. 3, line 66). Crisanti et al. teach the inclusion in the acidic composition, having a preferred pH of 3 (col. 9, line 25), of an anionic surfactant including a sulfonate (col. 5, line 35 et seq) and a nonionic surfactant (col. 6, line 53 et seq). The prior art, Crisanti et al., are silent as to the claimed composition in terms of a log reduction protocol against one or more of *Staphylococcus aureus* and *Pseudomonas aeruginosa* inter alia as called for by claim 20. However, it is reasonable to presume that said limitations are encompassed by the invention of Crisanti et al. because the presumption is supported by the use of similar materials (i.e. citric acid, an anionic surfactant including a sulfonate, a nonionic surfactant, and glycol ether solvent) and in the similar production steps (i.e. formulated in to a hard surface cleaning composition) to produce the germicidal acidic hard surface cleanser. The burden is upon the applicant to prove otherwise. In re Fitzgerald, 205 USPQ 594. Crisanti et al.

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do not specifically teach the exclusion of the claimed components recited in independent claims 1, 21, and 23. Crisanti et al. does teach that while preservatives may be added in minor amounts, these preservatives do not include a disinfectant component (col. 8, line 45 et seq). It would have been obvious, to one of ordinary skill in the art, to arrive at a hard surface cleaner excluding the claimed components with a reasonable expectation of success and similar results, because Crisanti et al. provide motivation to one of ordinary skill to exclude antimicrobials as recited by the instant independent claims, because Crisanti et al. teach formulations having antimicrobial efficacy as they were found effective against gram positive *Staphylococcus aureus* and gram negative *Pseudomonas aeruginosa* (col. 18, line 45 et seq) and Crisanti et al specifically teach the exclusion of known disinfectants in general.

Response to Arguments

6. Applicant's arguments filed 10/29/07 have been fully considered but they are not persuasive:

a. Applicants argue on that claims 22 and 24 have been amended to overcome the rejection under 112(2); however, the instant claims 22 and 24 have not been amended. It is unclear as to which claims are being argued.

b. Applicants argue that the scope of the claims is readily understood from the specification. The examiner respectfully disagrees and notes that that the court has held that compositions are indefinite for being defined in terms of properties alone. *Ex parte Spacht*, 165 USPQ 409 (PO Bd Pat App 1969); *Ex parte Slob* 157 USPQ 172 (PO Bd Pat App 1967); *Ex parte Pulvari*, 157 USPQ (PO Bd Pat. App 1966). In particular, it is suggested that if specific chemicals are to be excluded, they should be listed in the claims.

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c. Applicants argue that the Crisanti reference is wholly silent regarding the efficacy against fungi (page 9) and is directed to a composition that has a "dual-solvent system" which is not required in the applicants' composition (page 10). The examiner respectfully disagrees and notes that even though Crisanti does not teach fungi deterrent use of the composition, the different intended uses are not distinguishable in terms of the composition, see *In re Thuau*, 57 USPQ 324; *Ex parte Douros*, 163 USPQ 667; and *In re Craige*, 89 USPQ 393. Also, it is noted that the court has held that that a material and its properties are inseparable. *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). Hence, the composition of Crisanti has the same efficacy against fungi since it has the same ingredients. Furthermore, it is noted that "comprising" leaves the claim open for the inclusion of unspecified ingredients even in major amounts, see *Ex parte Davis et al.*, 80 USPQ 448 (PTO Ed. App. 1948). Also, the broad "comprising" and "containing" terminology do not exclude the presence of other ingredients in the composition, unlike the narrow "consisting of" language, see *Swain v. Crittendon*, 332 F.2d 820, 14 USPQ 811 (CCPA 1964) and that "consisting essentially of" language does not necessarily exclude the dual system of Crisanti because "consisting essentially of" renders the composition open to the inclusion of unspecified ingredients which do not materially affect the basic and novel characteristics of the composition, see *Ex parte Davis et al.* (Bd of Appeals), 80 USPQ 448.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TRI V. NGUYEN whose telephone number is (571)272-6965. The examiner can normally be reached on M-F 8:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/T. V. N./
Examiner, Art Unit 1796
June 25, 2008

/Lorna M Douyon/
Primary Examiner, Art Unit 1796

